

REMARKS

1. Formal Matters

a. Status of the claims

Claims 21-23 and 32-36 are pending in the instant application. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of the present application.

b. July 11, 2007 Interview

The undersigned would like to thank Examiner Shin for the courtesy of granting a personal interview on July 11, 2007 during which the priority date imputed to SEQ ID NO: 3588 was discussed. This Reply is filed to address the issues raised by the Examiner.

c. Amendments to the claims

Claim 22 has been amended to recite, “[A]n isolated nucleic acid consisting of 24 to 120 nucleotides, wherein the sequence of the nucleic acid comprises (a) SEQ ID NO: 3588, (b) an RNA equivalent of (a), or (c) the complement of (a) or (b).” Support for amended claim 22 can be found at claim 21 as originally filed.

Claims 32-35 have been amended to be in independent format. Support for these amended claims can be found in either claim 21 or claim 23.

2. Patentability Remarks

a. 35 U.S.C. § 102(e) over Mounts et al.

On page 4 of the Office Action, the Examiner rejects claims 21, 23, 32, and 33 under 35 U.S.C. § 102(e) over Mounts *et al.* (U.S. Patent Pub. No. 2007/0031850; hereafter “Mounts”). The Examiner asserts that Mounts teaches an isolated nucleic acid of 25 nucleotides in length comprising SEQ ID NO: 273968 and an isolated nucleic acid of 25 nucleotides in length comprising SEQ ID NO: 273971 that are 80% identical to a 23-nucleotide region of SEQ ID NO: 3588. In view of foregoing priority information of SEQ ID NO: 3588, Applicant respectfully submits that the rejection is rendered moot.

Specifically, the present application claims priority to U.S. Provisional Application No. 60/457,788 filed March 27, 2003 (hereafter the ‘788 application). As submitted herewith in Appendix A, Figure 877B of U.S. Provisional Appl. No. 60/457,788 teaches the 24 nucleotide sequence as set forth in SEQ ID NO 3588. Although Figure 877B of the ‘788 application is not present in the United States Patent and Trademark Office’s Private Pair system, this figure, along with the sequence of SEQ ID NO: 3588, were originally submitted on compact discs along with the ‘788 application on March 27, 2003. Submitted herewith in Appendix B is the USPTO filing receipt acknowledging receipt of the ‘788

application and accompanying compact discs. In addition, to the compact discs, Figure 877b and its description can be found in the following folder and files on the submitted compact discs.

Folder Name: Description & Figs 17-2739 2741-3297\Figs17-2739, 2741-3297

File Names: fig-000877_001.tif

fig-000877_0002.tif

fig-000877_0003.tif

These files clearly indicate that SEQ ID NO: 3588 is disclosed by priority U.S. Prov. Appl. No. 60/457,788. Applicant respectfully submits that in view of this evidence, Mounts is an improper §102(e) reference because Mounts has a priority date of June 3, 2003, in contrast to Applicant's priority of SEQ ID NO: 3588 of March 27, 2003 as disclosed in U.S. Prov. Appl. No. 60/457,788. In view of the foregoing remarks, Applicant submits that the rejection of claims 21, 23, 32, and 33 under 35 U.S.C. § 102(e) is moot and should be withdrawn.

b. 35 U.S.C. § 103 over Mounts et al. in view of Paul et al.

On pages 5 and 6 of the Office Action, the Examiner rejects claims 21, 23, 32, 33, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Mounts in view of Paul et al., Nature Biotechnology 29:505-508 (2002; hereafter Paul). Applicant respectfully submits that the rejection is moot in view of the fact that SEQ ID NO: 3588 is taught in U.S. Prov. Appl. No. 60/457,788, which predates the priority date of Mounts. Accordingly, Mounts is not a proper reference under 35 U.S.C. §103.

Applicant further submits that Paul cannot stand alone as a proper §103 reference. Specifically, Paul does not teach or suggest SEQ ID NO: 3588. In view of the foregoing, claims 21, 23, 32, 33, and 36 are not obvious over the teachings of Paul. In view of the foregoing, the rejection of claims 21, 23, 32, 33, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Mounts in view of Paul et al. is overcome due to the inapplicability of Mounts and the failures of Paul and should be withdrawn.

3. Conclusion

The Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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